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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/736,293

Filing Date: 12/16/2003

Applicant(s): Mustansir Banatwala,
Stephen J. Foley and
Alexander Kordun

Entitled: MANAGING EXTERNAL DATA SOURCES IN A
DISCUSSION FORUM RESOURCE

Examiner: Maceeh Anwari

Group Art Unit: 2109

Attorney Docket No.: LOT920030103US1 (7321-039U)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal filed October 18, 2007 and in response to the Notice of Non-Compliant Appeal Brief mailed April 16, 2008. As this Appeal Brief has been timely filed within the shortened statutory period of one month from the date of the Notice of Non-Compliant Appeal Brief, no extension of time under 37 C.F.R. § 1.136 is required. Notwithstanding, please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: May 16, 2008

Respectfully submitted,

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PATENT

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed October 18, 2007, wherein Appellant appeals from the Examiner's rejection of claims 1, 2 and 4 through 13.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on December 16, 2003, at Reel 014808, Frame 0398.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 2 and 4 through 13 are pending in this Application and have been twice rejected. Claim 3 has been cancelled. It is from the multiple rejections of claims 1, 2 and 4 through 13 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

Claims 1, 4, 5, 9 and 13 were amended once in the Amendment filed on May 21, 2007 (the "Amendment") in response to the Non-Final Office Action dated February 21, 2007 (the "Non-Final Office Action"). Additionally, by way of the Amendment, Claim 3 has been cancelled. Otherwise, Claims 2, 6, 7, 8, 10, 11 and 12 have not been amended previously and their original form as of the filing date of the Application of December 16, 2003.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1, 5, 9 and 13 are respectively directed to a discussion forum resource, a discussion forum management method, a machine readable storage having stored thereon a computer program for discussion forum management, and a collaborative environment configured to include external data sources in a discussion forum resource. In the Applicants' invention, a discussion forum resource can be provided in which collaborators can post messages for viewing by other authorized collaborators. (Par [0019]) The posted messages can include text, audio, imagery or any combination thereof. (Par [0016]) The posted messages can be

posted in a single topic thread, or across multiple topic threads in the discussion forum resource. (Par [0020]).

Importantly, the discussion resource forum can be configured to incorporate externally sourced data or addressable links to externally sourced data, such as Web sites, remotely disposed media files, data from news groups, or even the postings of other discussion forums. (Par [0017]) Additionally, to the extent that the external source permits, postings relating to the externally sourced data can be provided to the external source for posting therein. (Par [0017]) More specifically, where the external source is an externally disposed discussion forum, postings relating to the externally sourced data can be posted in the externally disposed discussion forum. (Par [0017]).

Claim 1 as amended recites a discussion forum resource (Fig. 1, Element 140 and Par [0018]) including at least one topic thread disposed in the discussion forum resource forum (Fig. 1, Element 150 and Par [0019]) and created for externally sourced content in the discussion forum resource (Fig. 1, Element 170 and Par [0019]). The externally sourced content can include postings from another discussion forum resource. (Par [0020]) The resource further can include a data aggregator executing in a computing platform and coupled to the at least one topic thread and configured to manage the externally sourced content in the at least one topic thread. (Fig. 1, Element 160 and Par [0019]).

Claim 5, as amended, recites a discussion forum management method. The method can include receiving externally sourced data for posting in a discussion forum resource (Par [0020]),

creating a new topic thread for said externally sourced data (Par [0020]), and responsively posting to said externally sourced data in said new topic thread (Par [0020]).

Similarly, Claim 9 as amended recites a machine readable storage having stored thereon a computer program for discussion forum management, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of receiving externally sourced data for posting in a discussion forum resource (Par [0020]), creating a new topic thread for said externally sourced data (Par [0020]), and responsively posting to said externally sourced data in said new topic thread (Par [0020]).

Finally, Claim 13 as amended recites a collaborative environment configured to include external data sources in a discussion forum resource. (Par [0019]) The environment can include at least two discussion forum resources coupled to each other (Par [0021]), and a data aggregator executing in a computer platform and disposed between said at least two discussion forum resources (Fig. 1, Element 160 and Par [0019]) and configured to synchronize postings related to one another in said at least two discussion forum resources (Fig. 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2 and 4 through 13 have been rejected under 35 U.S.C. § 101.

Claims 1, 2 and 4 through 13 have been rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 2 and 4 through 13 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2001/0028364 by Fredell et al. (Fredell).

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1, 2 AND 4 THROUGH 13 UNDER 35 U.S.C. § 101.

In the Final Office Action dated July 17, 2007, the Examiner rejected claims 1-13 under 35 U.S.C. § 101 due to the perception that the recited claims represent non-statutory subject matter. The rejection under 35 U.S.C. § 101 set forth in the Final Office Action repeats verbatim the rejection under 35 U.S.C. § 101 set forth in the Non-Final Office Action dated February 21, 2007. In the Amendment following the Non-Final Office Action, however, the Applicants observed that in *State Street Bank and Trust Company v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed Cir. 1998), the court set forth the criteria for establishing statutory subject matter under 35 U.S.C. § 101 – namely, the test for determining whether subject matter is patentable under 35 U.S.C. § 101 involves deciding if the subject matter produces a "useful, concrete, and tangible result."

The Applicants particularly directed the Examiner to M.P.E.P. § 2107.02 in which it is stated:

regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112

Finally, in the Amendment the Applicants referred to paragraph [0017] of Applicants' disclosure. Paragraph [0017] recites disclosure sufficient to support claims 1, 5, 9 and 13. The disclosure teaches that when an external source of externally sourced data in one discussion resource forum is another externally disposed discussion forum, postings relating to the externally sourced data can be posted in the other, externally disposed discussion forum. In consequence, the Applicants concluded in the Amendment that indeed, a credible utility had been asserted.

In the Amendment, the Applicants especially referred to M.P.E.P. § 2107.02(III)(A), citing to the Court of Customs and Patent Appeals in *In re Langer* in which it was stated with clarity:

As a matter of Patent Office practice, **a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient** to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. (emphasis in original)

Thus, the Applicants concluded in the Amendment that, since a credible utility had been contained in Applicants' specification and since the scope of independent claims 1, 8 and 12 tracked the asserted credible utility, the utility requirement of 35 U.S.C. § 101 (i.e., whether the invention produces a useful, concrete, and tangible result had been met.

Even still, in the Final Office Action, the Examiner now states that the Applicants meet the "credible utility" requirement but "still fail to fall under a statutory category and is software per se". At the outset, Applicant notes that the Examiner has failed to cite any case law that supports the Examiner's position. The Examiner's role is to apply the law, not to make law; and thus, unless the Examiner can support the Examiner's legal conclusion with case law, Applicant submits that the Examiner has improperly attempted to establish new law.

In this regard, the Examiner cites no legal support for a "software per se" test. The Examiner states that because the "present invention can be realized in hardware or software or a combination thereof", the claims of the Applicants fail to meet the statutory requirement. This is an absurd statement of the law as applied to the facts. In that an invention can be embodied within a computing platform of software and hardware components does not automatically render a claim invalid under 35 U.S.C. § 101 as recognized by the Court of Appeals for the Federal Circuit.

Rather, as the Court of Appeals for the Federal Circuit has already set forth as recently as in In re Comiskey, 2007 WL 2728361 (Fed. Cir. Sept. 20, 2007), a claim reciting an algorithm or abstract idea can state statutory subject matter if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. The Applicants already have clearly established that postings relating to externally sourced data can be posted in another, externally disposed discussion forum so as to perform the requisite transformation. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 2 and 4 through 13 under 35 U.S.C. § 101.

THE REJECTION OF CLAIMS 1, 2 AND 4 THROUGH 13 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH.

In the Final Office Action, the Examiner stated, "The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time application was filed had possession of the invention." Namely, the Examiner objected to the introduction of the term computing platform as a claim limitation. Yet, it is plain to see from Figure 1 that a computing platform is present in the form of the collaborative host 130. The Examiner has provided absolutely no factual or legal support for the Examiner's assertion that the one skilled in the art would not recognize the equivalence of the picture of a computing platform with the text "computing platform". Because Figure 1 provides ample support for the equivalence, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 2 and 4 through 13 under 35 U.S.C. § 112, first paragraph.

**THE REJECTION OF CLAIMS 1, 2 AND 4 THROUGH 13 UNDER 35 U.S.C. § 102 AS BEING
U.S. PATENT PUBLICATION NO. 2001/0028364 BY FREDELL.**

For convenience of the Honorable Board in addressing the rejections, claims 2 and 4 stand or fall together with independent claim 1, claims 6, 7 and 8 stand or fall together with claim 5, and claims 10, 11 and 12 stand or fall together with independent claim 9.

Applicants' Claim 1 refers explicitly to a "a topic thread disposed in a discussion forum". and "the management of externally sourced content in the thread" where "the externally sourced content is a posting from another discussion forum resource." *Nowhere in Fredell is there a teaching directed to externally sourced content comprise postings from another discussion forum resource as expressly required by claim 1.* Claim 1 recites as follows:

1. A discussion forum resource comprising:
 - at least one topic thread disposed in the discussion forum resource and created for externally sourced content in the discussion forum resource, wherein said externally sourced content comprise postings from another discussion forum resource; and,
 - a data aggregator executing in a computing platform and coupled to said at least one topic thread and configured to manage said externally sourced content in said at least one topic thread.

Likewise, Claims 5 and 9 further require the creation of a new topic thread for externally sourced data. Exemplary Claim 5 recites as follows:

5. A discussion forum management method comprising the steps of:
 - receiving externally sourced data for posting in a discussion forum resource;
 - creating a new topic thread for said externally sourced data; and,
 - responsively posting to said externally sourced data in said new topic thread.

As of the Final Office Action, the Examiner has not provided adequate identification of a teaching in Fredell that equates to the creation of a new topic thread for externally sourced data and *in the Examiner's rebuttal in the Final Office Action, the Examiner provided not a single reference to a single passage in Fredell in support of the naked assertion, "Fredell does teach that a new topic thread is created for externally sourced data".*

Finally, claim 13 requires the synchronization of postings relating to one another in at least two discussion forum resources. Claim 13 as amended recites:

13. (Currently Amended) A collaborative environment configured to include external data sources in a discussion forum resource comprising:

at least two discussion forum resources coupled to each other; and,

a data aggregator executing in a computer platform and disposed between said at least two discussion forum resources and configured to synchronize postings related to one another in said at least two discussion forum resources.

Yet again, the Examiner provides no credible support anywhere in Fredell for this limitation and refers only to Paragraph 11 of Fredell. Paragraph 11, reproduced in its entirety states,

[0011] In another aspect thereof, the present invention allows for providing a system for communicating and managing project information. The system comprises a database configured to store project-related information including project documentation. The system further comprises an interface screen available through a global communications network. The interface screen is configurable to identify a plurality of project tasks. The interface screen includes a data field for defining a respective time window over which each of said tasks is to be performed by at least one project participant. A posting module is configured to post over the global communications network to selected project participants the plurality of project tasks. The posted plurality of project tasks is linkable to the database to retrieve project documentation that requires review by said selected project participants. A project status screen is indicative of the status of respective ones of the plurality of tasks. The project status screen is responsive to project status data communicated over the global communications by respective project participants.

Clearly the concept of two different discussion forum resources are lacking in paragraph [0011] as is the concept of synchronizing postings between two different discussion forum resources. So much is required by the plain language of Claim 13, however.

In as much as the Examiner has failed to locate each and every element set forth in claims 1, 5, 9 and 13, the Examiner has not set forth a prima facie case of anticipation. See M.P.E.P. 2131 in which it is stated, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Based upon the foregoing, Appellant respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 101, 112 first paragraph, and 102(b) for anticipation based upon the applied prior art are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 112 first paragraph, and 102(b).

Date: April 13, 2008

Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg

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VIII. CLAIMS APPENDIX

1. (Previously Amended) A discussion forum resource comprising:
at least one topic thread disposed in the discussion forum resource forum and created for externally sourced content in the discussion forum resource, wherein said externally sourced content comprise postings from another discussion forum resource; and,
a data aggregator executing in a computing platform and coupled to said at least one topic thread and configured to manage said externally sourced content in said at least one topic thread.
2. (Original) The discussion forum resource of claim 1, wherein said externally sourced content comprise data selected from the group consisting of text, audio, imagery and video.
3. Cancelled.
4. (Previously Amended) The discussion forum resource of claim 1, wherein said data aggregator further comprises a configuration for writing responsive postings in said at least one topic thread disposed in the discussion forum resource to said another discussion forum resource.
5. (Previously Amended) A discussion forum management method comprising the steps of:
receiving externally sourced data for posting in a discussion forum resource;
creating a new topic thread for said externally sourced data; and,
responsively posting to said externally sourced data in said new topic thread.

6. (Original) The method of claim 5, further comprising the steps of:
determining whether subsequently received postings are responsive postings which relate to said externally sourced data; and,
posting said subsequently received postings to said external data source if it is determined that said subsequently received postings are responsive postings which relate to said externally sourced data.
7. (Original) The method of claim 5, wherein said externally sourced data comprises data selected from the group consisting of text, audio, imagery and video.
8. (Original) The method of claim 5, wherein said externally sourced data comprises postings for another discussion forum resource.
9. (Previously Amended) A machine readable storage having stored thereon a computer program for discussion forum management, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of:
receiving externally sourced data for posting in a discussion forum resource;
creating a new topic thread for said externally sourced data; and,
responsively posting to said externally sourced data in said new topic thread.

10. (Original) The machine readable storage of claim 9, further comprising the steps of:
determining whether subsequently received postings are responsive postings which relate to said externally sourced data; and,
posting said subsequently received postings to said external data source if it is determined that said subsequently received postings are responsive postings which relate to said externally sourced data.
11. (Original) The machine readable storage of claim 9, wherein said externally sourced data comprises data selected from the group consisting of text, audio, imagery and video.
12. (Original) The machine readable storage of claim 9, wherein said externally sourced data comprises postings for another discussion forum resource.
13. (Previously Amended) A collaborative environment configured to include external data sources in a discussion forum resource comprising:
at least two discussion forum resources coupled to each other; and,
a data aggregator executing in a computer platform and disposed between said at least two discussion forum resources and configured to synchronize postings related to one another in said at least two discussion forum resources.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.